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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCK ROLAND

Appeal 2010-000298
Application 10/576,031
Technology Center 2800

Before JOSEPH F. RUGGIERO, THOMAS S. HAHN, and CARL W.
WHITEHEAD, JR., *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Introduction

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 11-23. Appeal Brief. 2. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

Exemplary Claim

Exemplary independent claim 11 under appeal reads as follows:

11. An inking roller for an inking unit of an offset printing press comprising:

a plurality of zones arranged in a direction of an axis of rotation;

at least one ink reservoir in an interior of the inking roller connected to at least one ink exit in a circumferential surface of the inking roller in each of the plurality of zones; and

at least one pumping element in each of the plurality of zones in the interior of the inking unit for conveying ink from the ink reservoir to the circumferential surface of the inking roller;

the inking roller being an offset printing press inking roller.

Rejections on Appeal

Claims 11-13, 15-16, and 18-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barrois (U.S. Patent Number 5,282,419; issued February 1, 1994) and Gandelheidt (GB 2314292 A; issued December 12, 1997). Answer 4-5.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Barrois, Gandelheidt, and Wagner (U.S. Patent Number 3,738,269; issued June 12, 1973). Answer 6.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Barrois, Gandelheidt, and Wingo (U.S. Patent Number 5,036,761; issued August 6, 1991). Answer 6-7.

PRINCIPLES OF LAWS

A flexible teachings, suggestions, or motivations (TSM) test remains the primary guarantor against a non-statutory hindsight analysis. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1260 (Fed. Cir. 2007) (“[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention.”).

The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence-teachings, suggestions (a tellingly broad term), or motivations (an equally broad term)-that arise before the time of invention as the statute requires. As *KSR* requires, those teachings, suggestions, or motivations need not always be written references but may be found within the knowledge and creativity of ordinarily skilled artisans.”

Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc., 520 F.3d 1358, 1364 (Fed. Cir. 2008).

Issue on Appeal

Did the Examiner err in rejecting claims 11-23 over the various 35 U.S.C. 103(a) rejections?

ANALYSIS

Claims 11-13, 15, 16, and 18-23

Appellant argues Barrois merely discloses bores that are conventionally arranged and does not teach an inking roller having “a plurality of zones arranged in a direction of an axis of rotation” as the

Examiner found. Appeal Brief 5. The Examiner finds that both Barrois and Gandelheidt teach a plurality of ink bores arranged in a direction of an axis of rotation, and the Examiner further contends, although neither reference explicitly designates zones, the claim limitations do not structurally distinguish the claimed zones from the structures taught in the prior art.

Answer 7. We do not find the Appellant's arguments to be persuasive and we agree with the Examiner because the claim limitation does not distinguish from the prior art as can be seen in Barrois' Figure 2 and Gandelheidt's Figure 3.

Appellant also argues Gandelheidt does not disclose the claimed pumping element and further, Gandelheidt does not teach an inking roller, but merely discloses a printing cylinder which directly prints a web. Appeal Brief 5-6. The Examiner contends that Gandelheidt was not relied upon to disclose an inking roller; Gandelheidt was relied upon to disclose individual pumps as an alternative method of supplying ink from an ink reservoir.

Answer 7. The Examiner concludes both Gandelheidt and Barrois are in the same field of endeavor and further Gandelheidt addresses supplying ink from a central reservoir to the exterior of a roller and is therefore pertinent to the problem addressed by Appellant's invention. Answer 8. We agree with the Examiner's findings and conclusion, and we are not persuaded by the Appellant's arguments.

The Examiner equates Gandelheidt's bores 5 to the claimed plurality of zones. *See* Answer 4. Appellant argues Gandelheidt's bores 5 are arranged radially and along the axis of rotation wherein each bore has a separate pump. Appeal Brief 6. Appellant concludes, "[t]his is different from the present invention, as claimed, where the zones are only arranged along the axis of rotation (not radially) and each separate zone 20 has its

own pump 26 (which serves a plurality of ink exits 12).” *Id.* We do not find Appellant’s arguments to be persuasive because they are not commensurate with the scope of the claims. Appellant admits Gandelheidt’s bores are arranged along the axis of rotation. *Id.* In addition, the claim limitation does not confine the bores or zones to only be arranged along the axis of rotation.

Appellant argues the combination of Barrois and Gandelheidt results from impermissible hindsight and the Examiner has not articulated any reason why one of ordinary skill in the art would add the pumping elements of Gandelheidt’s printing cylinder to the inking roller of Barrois. Appeal Brief 7. We do not find Appellant’s arguments to be persuasive because the Examiner has shown that the references are in the same field of endeavor and has articulated a reason why one of ordinary skill in the art would combine the two references. *See* Answer 4, 7, and 8; *also see Ortho-McNeil Pharm., Inc.*, 520 F.3d at 1364.

Claim 14

Appellant argues the rejection is based upon hindsight reasoning and it is not understood how the material of Wagner would distribute ink more evenly as asserted. Appeal Brief 8. Appellant notes the material employed by “Wagner operates by capillary action that is not ordinarily needed or necessary with any pump as claimed.” *Id.* Wagner was cited to disclose an “ink exit includes a perforated plug.” Answer 6. We do not find the Appellant’s arguments to be persuasive because whether or not modifying Barrois and Gandelheidt to include an ink exit with a perforated plug improves the ink distribution is immaterial to the integration of the plug.

Appellant argues that Wingo discloses a roller for feeding water and not an inking roller as asserted. Appeal Brief 9. Further, Appellant argues Wingo does not disclose the claimed “a number of ink exits” and Examiner has failed to explain how one of ordinary skill in the art would adapt the water design of Wingo for use in the claimed printer roller. *Id.* Examiner finds Wingo teaches an inking roller having a number of ink exits present in one zone with the ink exits being located in a circumferential direction either in one angular section of a circumference in an accumulative way or distributed in a substantially even manner. Answer 6-7.

Examiner asserts Wingo is in the same field of endeavor as printing ink rollers because dampening or water rollers have similar structures. Answer 8. Also, Wingo is concerned with the delivery of a fluid from a central reservoir to the exterior of a roller and is therefore pertinent to the problem Appellant’s invention attempts to address. Answer 9. We do not find the Appellant’s arguments to be persuasive because the Examiner has indicated where Wingo discloses the “number of ink exits” and therefore Appellant’s argument concerning Wingo’s non-disclosure is not persuasive.

If the Examiner’s burden to establish a *prima facie* case of unpatentability is met, the burden then shifts to the Appellant to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). We agree with the Examiner that one of ordinary skill in the art would adapt Wingo’s teachings within an inking roller because both involved the distribution of fluid within a roller or cylindrical element. We will sustain the Examiner’s rejection for the reasons stated above.

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DECISION

The Examiner has not erred in rejecting claims 11-23 under the various 35 U.S.C. §103(a) rejections.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv)(2010).

AFFIRMED

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